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Dated: June 15, 2010

Electronic Signature for Anthony A. Laurentano: /Anthony A. Laurentano/

Docket No.: RMI-018
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Randell L. Mills

Application No.: 09/220,970

Confirmation No.: 5381

Filed: December 23, 1998

Art Unit: 2624

For: METHOD AND SYSTEM FOR PATTERN
RECOGNITION AND PROCESSING

Examiner: W. Chen

PETITION FOR REVIEW PURSUANT TO 37 C.F.R. §1.181

MS Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. §1.181, Applicants hereby request review of the Patent Term Extension calculated in the Notice of Allowance mailed on March 15, 2010 in the above-identified patent application. The issue fee and fee for filing an application for Patent Term Adjustment as set forth in 37 C.F.R. §1.18(e) are filed herewith. Although there is no fee specified in §1.18(e) for a Patent Term Extension recalculation (for a case filed between June 8, 1995 and May 28, 2000), Applicants believe that the appropriate fee is the same as for a Patent Term Adjustment recalculation.

The Notice of Allowance in the present Application indicates that the applicable amount of patent term extension has been calculated at 558 days. Applicants respectfully submit that the appropriate amount of patent term extension is 1743 days. The bases for the adjustment and relevant dates for which adjustment is sought are set forth below.

I. Background

A. Applicable Rules

The present application was filed on December 23, 1998; accordingly, the Patent Term Extension rules under former 35 U.S.C. §154(b) for applications filed between June 8, 1995 and May 28, 2000 are applicable (see MPEP §2720). The Code provides, in relevant part:

(b) TERM EXTENSION.-

...

(2) EXTENSION FOR APPELLATE REVIEW. -If the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than 5 years. A patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.

(3) LIMITATIONS.-The period of extension referred to in paragraph (2)-

(A) shall include any period beginning on the date on which an appeal is filed under section 134 or 141 of this title, or on which an action is commenced under section 145 of this title, and ending on the date of a final decision in favor of the applicant;

(B) shall be reduced by any time attributable to appellate review before the expiration of 3 years from the filing date of the application for patent; and

(C) shall be reduced for the period of time during which the applicant for patent did not act with due diligence, as determined by the Commissioner.

(4) LENGTH OF EXTENSION.-The total duration of all extensions of a patent under this subsection shall not exceed 5 years.

The present application is not subject to a terminal disclaimer. A statement of relevant facts is set forth below.

II. Summary of Prosecution History

A. Initial Prosecution

As noted above, the present Application was filed on December 23, 1998. A first, non-final Office Action was mailed on September 3, 1999, rejecting the claims under 35 U.S.C. §101. An amendment was filed on January 27, 2000, canceling the pending claims (1-50) and

replacing the claims with new claims 51-322. A second non-final Office Action was mailed on March 14, 2000, objecting to the Specification and rejecting the claims under 35 U.S.C. §101 and §112, and further under §102(b) as being anticipated by Bates.

B. First Appeal

A Notice of Appeal was filed on July 11, 2000 (with a one-month extension of time). An Appeal Brief was filed on February 9, 2001 and a corrected Appeal Brief was filed on April 3, 2001.

In response to the Appeal Brief, the Examiner issued a third non-final Office Action on July 19, 2001, withdrawing the §112 rejections, raising new objections to the Specification and claims, and further issuing new rejections under 35 U.S.C. §101 and §112. The Examiner also rejected the claims under §102(e) as being anticipated by Kortge and Caid, and under §103(a) as being obvious over various combinations of Kortge, Streit, Caid, Dickhaus, Greenspan, and Levien. The Examiner indicated that either a reply could be filed under 37 C.F.R. §111, or a reinstatement of the appeal could be requested.

Applicants reinstated the appeal by filing a Notice of Appeal on August 27, 2001. A supplemental Appeal Brief was filed on February 27, 2001, along with an amendment for reducing the issues on appeal. A revised Appeal Brief was filed on April 25, 2002.

The Decision of the Board was mailed on March 22, 2005, remanding the application to the Examiner. In the Decision, the Board specifically noted that the Examiner, in the July 19, 2001 Office Action, had provided only “a discussion of Caid without specific reference to any particular claim, and then provides a specific discussion for only claim 304” (Decision at page 5). The Board noted that there was not a one-to-one correspondence between the claims and the cited Caid reference, and the Board “found no disclosure” of the claimed “Fourier Series in Fourier Space” in Caid (Decision at page 5). The Board found that “the claims rejected over prior art distinguish over the applied prior art, for the reasons set forth by Appellant in the briefs” (Decision at page 9).

The Board requested that the Specification be amended to more clearly describe the term “Fourier Series in Fourier Space,” an amendment which the Board indicated “would not

introduce new matter into the specification” because “there is adequate basis for these terms in the originally filed specification” (Decision at page 9). Accordingly, the Board remanded the application to the Examiner so that Applicants could file an amendment and so that the Examiner could reconsider the Application. Applicants filed the Amendment on May 3, 2005.

C. Subsequent Prosecution and Second Appeal

In the March 22, 2005 Decision, the Board (citing MPEP §708.01(d)) instructed that “this Application, by virtue of its ‘special’ status, requires immediate action by the examiner” (Decision at page 12, emphasis in original). Nonetheless, a fourth non-final Office Action was not issued until December 21, 2006, nearly 20 months after Applicants filed the amendment requested by the Board.

In the fourth non-final Office Action, the Examiner issued new rejections under 35 U.S.C. §101 and §112. A second appeal was initiated with the filing of a Notice of Appeal on May 21, 2007 (with a two-month extension of time). An Appeal Brief was filed on September 21, 2007.

The Board mailed a Decision on November 28, 2008. The Board reversed the Examiner’s §112 and §101 rejections and entered new grounds of rejection under 35 U.S.C. §101 (Decision at page 2).

D. Subsequent Prosecution

On January 28, 2009, Applicants filed an amendment addressing the Board’s §101 concerns. A fifth, non-final Office Action was mailed on March 31, 2009, raising new rejections under 35 U.S.C. §101 and §112. An amendment was filed on June 29, 2009. Subsequently, an *Ex Parte Quayle* Action was mailed by the Examiner on October 23, 2009, objecting to the Drawings. Applicants responded on December 22, 2009 with a Response and Replacement Drawing.

A Notice of Allowance was issued on March 15, 2010.

III. Analysis

Applicants have been credited 558 days of patent term extension for the second appeal only (i.e., from the filing of the Notice of Appeal until the Decision of the Board). However, the first appeal also reversed the Examiner's adverse determination and remanded the case to the Examiner. Indeed, the only issues remaining after the first appeal were §101 rejections, which were ultimately reversed by the Board in the second appeal.

The MPEP at §1.701 acknowledges that certain remands from the Board to the Examiner should be considered a delay due to appellate review by the Board of Patent Appeals and Interferences wherein the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability. Applicants respectfully submit that the first appeal, which ended with the Board noting that the cited prior art did not correspond to Applicants' claims and remanding the case back to the Examiner, should be considered a delay due to appellate review falling within the meaning of former §154(b). The "remand" language was added to §1.701 specifically because the Office acknowledges that "there are a number of BPAI panel remands that convey the weakness in the examiner's adverse patentability determination in a manner tantamount to a decision reversing the adverse patentability determination" ("Revision of Patent Term Extension and Patent Term Adjustment Provisions Related to Decisions by the Board of Patent Appeals and Interferences," Federal Register Vol. 68, No. 233, page 67818 (December 4, 2003)).

Applicants respectfully submit that the remand in the first Board Decision conveys the weakness of the Examiner's adverse patentability determination in a manner tantamount to a decision reversing the adverse patentability determination. Accordingly, the delay due to the first appeal (in addition to the delay due to the second appeal) should be considered "*a delay due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court*" wherein "*the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability*" within the meaning of former 35 U.S.C. §154(b).

Under former §154(b), the amount of time credited to an applicant for Patent Term Extension purposes *includes any period beginning on the date on which an appeal is filed under section 134 or 141 of this title, or on which an action is commenced under section 145 of this title, and ending on the date of a final decision in favor of the applicant, and is reduced by any*

time attributable to appellate review before the expiration of 3 years from the filing date of the application for patent.

The first Notice of Appeal was filed on July 11, 2000 and the final decision in favor of the Applicants on the first appeal was mailed on March 22, 2005. This totals 1716 days and should be added to the 558 days originally credited for the second appeal, for a sum total of 2274 days.

However, this period of time is reduced by any time attributable to appellate review before the expiration of 3 years from the filing date of the application (i.e., December 23, 2001). As such, the period of time between July 11, 2000 and December 23, 2001 (531 days) should be subtracted from the extension time, for a total of 1743 days.

The statutory maximum is five years (or 1826.25 days). Accordingly, Applicants respectfully submit that they are entitled to a Patent Term Extension of 1743 days.

According to the MPEP §2720, review of a Patent Term Extension calculation under former 35 U.S.C. §154(b) is properly made by filing a petition under 37 C.F.R. §1.181. The requirements for such a petition are not provided in detail; nonetheless, under current practice pursuant to 37 C.F.R. §1.705, certain statements must be set forth in a Request for Reconsideration. Although it appears that several of these statements pertain to the amended version of 35 U.S.C. §154(b) which was in force after May 28, 2000, Applicants have attempted to conform as closely as possible with all of the requirements of a petition under both the present and past versions of 35 U.S.C. §154(b).

Applicants further note that, under the current version of §1.704, a patent term adjustment is reduced if an applicant responds to an official action more than three months after the mailing date of the action. Although Applicants do not believe that the provisions of §1.704 apply to the calculations under former 35 U.S.C. §154(b) (for which separate limitations are set forth which do not include the three-month requirement), for the sake of completeness and out of an abundance of caution Applicants note that a two-month extension of time totaling 61 days was taken in responding to the third non-final Office Action.

In view of the above, Applicants respectfully request that the present Petition be granted and that a Certificate of Correction be issued correcting the Patent Term Extension from 558 days to 1743 days.

CONCLUSION

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 12-0080, under Order No. RMI-018.

Dated: June 15, 2010

Respectfully submitted,

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